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INDONESIAN SUPREME COURT REJECTED PIERRE CARDIN CASSATION

After the shocking IKEA case decision, Indonesian court, once again, shows that the owner of well-known trademark might have to go through a long and winding road to enjoy protection of being well-known trademark in Indonesia. This time, this unfavourable ruling is happening to Pierre Cardin, a French based designer and global fashion enterprises.

On 30 November 2015, the Indonesian Supreme Court has issued Decision No. 557 K/Pdt.sus-HKI/2015 which rejected cassation filed by Pierre Cardin (“**Plaintiff/Appellant**”) against various registrations of “PIERRE CARDIN (word)” and “PIERRE CARDIN (Logo)” in classes 3 (“**Conflicting Trademarks**”) in the name of Alexander Satriyo Wibowo (“**Defendant/Respondent**”).

In its consideration, the Supreme Court stated, amongst others, the following:

(i) That the Respondent is the first user and registrant of PIERRE CARDIN trademark in Indonesia who has obtained the registration on 29 July 1977. When the Respondent filed application for the “PIERRE CARDIN” trademark, the said trademark has not been registered and known yet in Indonesia and therefore, it could be registered.

(ii) That the Conflicting Trademarks have distinctiveness with the Appellants’ registered “PIERRE CARDIN” trademarks due to the fact that in selling its products, the Respondent always put the sign “*Product by PT Gudang Rejeki*” as distinctive feature in addition to the description that the products are made in Indonesia. As such the Conflicting Trademarks are not intended to take unfair advantage of another trademark’s reputation and the Respondent’s registration for the Conflicting Trademarks cannot be qualified as a bad faith.

(iii) That the Respondent’s registrations for the Conflicting Trademarks have been in accordance with the first to file concept adopted in Indonesia.

Based on the verdict, we note that there was a dissenting opinion raised by one of the member of the panel of judges. The dissenting judge was of the view that:

“a trademark should not be seen merely as a name or word. The name and word used within a trademark are the distinctive factors of the trademark which are used to show the origin of such trademark. In this case, we know that Pierre Cardin is the real name of the Plaintiff. On the other hand, we also know that the “PIERRE CARDIN” element used by the Respondent on the Conflicting Trademarks are not languages or words originated from Indonesian Language but instead it is a foreign language which comes from the Appellant’s country of origin.

Therefore, in terms of morality and etiquette, using the first to file arguments to justify the registrations of the Conflicting Trademarks is totally unacceptable and this registration has clearly shown the Respondent’s bad faith and free riding of the Appellants’ reputation.”

Furthermore, prior to filing the cassation, the Appellant had actually filed cancellation claim at the Indonesian Commercial Court on 9 June 2015 based on, amongst others, bad faith and unfair competition arguments. However, this was also rejected by the ICC on the basis of the cancellation claim was deemed to be unacceptable due to the expiry period of 5 years as stipulated under Law No. 15 of 2001 on Trademark (“**Indonesian Trademark Law**”) Article 69 Paragraph(1) has lapsed.

In general, we believe that the Supreme Court verdict shows a confusion understanding of the judges over the concept of bad faith application and the implementation of first to file as well as similarity concept.

This fact also proves that although all the relevant evidences and arguments indicating the well-knownness of the actual trademark owner have been presented, there remains possibility this can be simply overlooked by the court. This means a successful prosecution for the well-known trademark owner in Indonesia would might have heavily depended on the judge’s wide discretion.

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